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EXAMINER

LIGHTFOOT, ELENA TSOY

ART UNIT	PAPER NUMBER
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1792

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11/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Advisory Action

The amendment filed on November 11, 2008 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because entry of a proposed amendment after final rejection cannot be made as a matter of right *unless it merely cancels claims or complies with a formal requirement made earlier*. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

Response to Arguments

Applicant's arguments filed November 11, 2008 have been fully considered but they are not persuasive.

Rejections Under 35 U.S.C. § 103

Applicants argue that Panush, Dattilo, Dutt and Jackson, whether taken individually or in combination, fail to teach or suggest a method "wherein the clear paint coating is a transparent coating and does not contain a color pigment" as recited in claim 1. Panush is directed to a "substrate material coated with at least two layers of polymer including a base coat ... and a transparent topcoat comprising a pigmented thermosetting." Panush, page 2, lines 3-5. Panush actually teaches away from the presently claimed invention, and thus is not an appropriate reference under § 103(a). Panush discloses "a final total coating system which is much stronger than a system with an untinted clear coat." Panush, page 7, lines 51-52 (emphasis added). The clear coating of Panush is a "color tinted clear coat [that] significantly reduces the penetration of solar energy and moisture, providing an intermediate that absorbs, reflects, and refracts solar energy and moisture ... and result[s] in lower and reduced ultraviolet rays reaching the base coat." Panush, page 7, lines 53-61. A person of skill in the art would not modify the method disclosed in Panush, which specifically states that a system with an untinted clear coat is much stronger, to incorporate a clear paint coating that "is a transparent coating and does not contain a color pigment" as presently claimed.

The Examiner respectfully disagrees with this argument. Panush teaches, "This system (untinted clear) requires selected base coat pigmentation. These pigments must be durable and

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moisture resistant and subsequently severely limits the range of colors producible" (See page 26, lines 14-17). Thus, **Panush actually teaches (*preferred*) tinted clear system and (*nonpreferred*) untinted clear system**. It is held that patents are relevant as prior art for all they contain. See *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."'). **NONPREFERRED EMBODIMENTS CONSTITUTE PRIOR ART. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or *nonpreferred* embodiments.** See MPEP 2123.

Panush teaches that color tinted clear coat provides an intermediate that **absorbs**, reflects *solar energy* and moisture, and thus becomes a protecting and glamorizing film permitting a more durable (stronger) system (See page 26, lines 19-26). Clearly the color tinted clear coat itself would be less durable than tinted clear coat because it **absorbs** *solar energy* and moisture, as evidenced by Dutt (See Dutt, P4). Obviously, a combination of untinted clear coat with a base coat containing durable and moisture resistant pigments should result in even more durable (stronger) system than a combination of tinted clear coat with a base coat containing ordinary less durable and moisture resistant pigments.

Dutt teaches that usually, applying a lightly pigmented clearcoat over a regular pigmented basecoat in the same color area significantly enhances the individual basecoat color shade and provide very deep, clean, vibrant, high end colors (See P3). However, **the tinted clear coats are not durable** (See P4). By replacing the tinted clear coat with a *regular untinted clear coat*, durability issues may be avoided, and the desired color enrichment may be obtained by using an intermediate basecoat layer instead of a tinted clearcoat (See P22). Dutt further teaches that a first basecoat may be solid color basecoat having a hiding power (See P27-28), and a second intermediate basecoat may have effect pigment (See P39).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced a tinted clear coat in a multi-layer coating of Panush in view of Dattilo with a regular *untinted* clear coat with the expectation of providing the multi-layer coating with the desired color enrichment and durable clear coat, as taught by Dutt

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Thus, claimed invention would be obvious over Panush, Dutt and Dattilo.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.
Primary Examiner
Art Unit 1792

November 18, 2008

/Elena Tsoy Lightfoot/